GP 3305

CVDINC.040FW3

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Yock, et al.
Appl. No.	:	08/904,438
Filed	:	July 31, 1997
For	:	APPARATUS FOR USE IN CANNULATION OF BLOOD VESSELS
Examiner	:	Unknown
Prior Examiner	:	Francis Jaworski

Group Art Unit: 3305

#29 2/17

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on

January 5, 1998
(Date)

Steven J. Natalupsky, Reg. No. 37,688

SUBMISSION OF SUPPLEMENTAL DECLARATIONS

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This paper addresses issues raised in the last Office Action mailed with respect to Application Serial No. 08/632,747, from which this application claims priority. Submitted herewith is the Supplemental Combined Power of Attorney and Declaration of Paul G. Yock and the Supplemental Combined Power of Attorney and Declaration of Alan R. Selfridge.

In the above-referenced Office Action, the Examiner stated his belief that the original reissue declarations were defective, alleging that they failed to particularly specify how the errors relied upon arose or occurred, as required under 37 C.F.R. § 1.175(a)(5). Applicants assert that the Supplemental Declarations submitted herewith satisfy the requirements of this rule.

In accordance with case law set forth by the Court of Appeals for the Federal Circuit, "reissue error is generally liberally construed". Mentor Corp. v. Coloplast, Inc., 27 U.S.P.Q.2d 1521, 1524 (Fed. Cir. 1993). As noted by the Federal Circuit, "[f]ailure of the attorney to claim the invention sufficiently broadly is one of the most common sources of defects." Scripps Clinic & Research Found. v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1009 (Fed. Cir. 1991). As such, Rule 175(a)(5) is complied with if statements in the declaration(s) accompanying the reissue application "show that the error relied upon is the attorney's failure to appreciate the full scope of the invention." In re Wilder, 222 U.S.P.Q. 369, 371 (Fed. Cir. 1984). This statement may be supplied solely by the applicant. See Advanced Cardiovascular Sys., Inc. v. Scimed Life Sys., Inc., 783 F. Supp. 413 (D. Minn. 1991) (in which a declaration statement by the applicant that the applicant was "unaware of how the error occurred but it obviously occurred during the preparation and prosecution of the application", was found sufficient to satisfy section 1.175(a)(5)).

In the instant case, the Supplemental Declarations clearly detail that the error arose because the attorney failed to appreciate the scope of the invention. As provided by the Applicants in the Supplemental Declarations:

> The attorney handling the prosecution of the original application, through error, without deceptive intent, failed to recognize the above-described features of the invention in their broadest sense and the aforesaid error which had occurred in the specification and claims.
>
> I am not sure how the aforesaid errors occurred, but I believe that they occurred during the preparation and prosecution of the application which issued as the original '606 patent.

Supplemental Combined Power of Attorney and Declaration of Paul G. Yock at ¶¶ 5 and 6;
Supplemental Combined Power of Attorney and Declaration of Alan R. Selfridge at ¶¶ 5 and 6.

In accordance with established case law, these statements by the Applicants are sufficient to satisfy the requirements of 37 C.F.R. § 1.175(a)(5).

The Examiner also stated that the original declarations failed to state how the new claims rectify the errors in the original claims. While Applicants believe that the original Declarations do supply this information, the Supplemental Combined Power of Attorney and Declaration of Alan R. Selfridge, as well as the Supplemental Combined Power of Attorney and Declaration of Paul G. Yock, clearly supply the desired information. These Supplemental Declarations detail each and every error, and how the previously filed amendments corrected the errors in the specification and/or claims. Similarly, the Supplemental Declarations detail how each new claim properly covers subject matter present in the original specification.

New Claims Directed to a Kit and Method for Guiding a Needle

In the Office Action, the Examiner also requested reasons why the subject matter claimed in Claims 14, 15 and 23 (to a kit and a method for guiding a needle) was not earlier claimed and otherwise not restrictable. By way of the previously filed Declarations, as well as the Supplemental Combined Powers of Attorney and Declarations filed herewith, Applicants have established that these errors occurred because the attorney prosecuting the original application, through error, without deceptive intent, failed to recognize the above-described features of the invention in their broadest sense. The addition of the above-referenced claims corrects these errors.

The case law supports Applicants addition of Claims 14, 15, and 23 to the application. The Supplemental Combined Powers of Attorney and Declarations and the claims themselves evidence that Claims 14, 15, and 23 are fully supported by the original specification. Since the original specification clearly details the inventions claimed in these claims and the inventions were not claimed as a result of the above-stated errors without deceptive intent, the claims are properly added to the application to remedy the errors. In re Wilder, 736 F.2d 1516 (Fed. Cir. 1984); In re Amos, 953 F.2d 613 (Fed. Cir. 1991); Scripps Clinic & Research Found. v. Genentech, Inc., 927 F.2d 1565 (Fed. Cir. 1991).

These claims are also properly added to this case and should not be subject to a restriction requirement. As set forth in MPEP § 803, two criteria must be established for a restriction to be proper: (1) the inventions must be independent and distinct; and (2) there must be a serious burden on the Examiner if restriction is not required. Whether or not the inventions claimed in Claims 14, 15 and 23 are "independent and distinct," Applicants assert that no "serious burden" exists justifying restriction. In this case, the Examiner has already conducted an examination of all of the claims, including Claims 14, 15 and 23, and found them all allowable. Since the claims as they presently exist have been allowed there will not be a burden on the Examiner to proceed without restriction. At this stage, a burden will only exist if a restriction is required. As a result, these claims should remain in the present application.

As all of the issues set forth in the Office Action are believed to have been addressed and all rejections therein overcome, Applicants respectfully request a Notice of Allowance as

to all claims. If the Examiner has any questions, the Examiner is encouraged to call the undersigned at the number set forth below.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: January 5, 1998

By: _____

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